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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,207	12/07/1999	JEREMY VANDER WOUDE	MPATENT.160A	7416
20995	7590	05/28/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			KUMAR, PANKAJ	
ART UNIT		PAPER NUMBER		2631
DATE MAILED: 05/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	WOUDE, JEREMY VANDER
Examiner Pankaj Kumar	Art Unit 2631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 April 2004.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3-5,8 and 11-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) 24-27 is/are allowed.
6) Claim(s) 1, 3-5, 8, 11-16, 19, 22, 23 is/are rejected.
7) Claim(s) 17,18,20 and 21 is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

1. DETAILED ACTION

2. *Response to Arguments*

3. Since in applicant's response there was an interview requested, John King was called on 5/19/2004. He was asked if he wanted to schedule an interview. He indicated he wants to see the rejection and then consider if he wants an interview.

4. Applicant argues that Carnahan is not testing since its system is used for demonstration and training. This is not persuasive since even when performing a demonstration, testing is performed beforehand to make sure the system works and so that the demonstration is successful.

5. As per applicant's argument that the primary and secondary communication links do not provide separate paths to the computer, this is a new limitation that has been addressed in the action below.

6. Applicant argues that all the disclosed links in Carnahan go through the LAN port to the computer and thus there is no secondary link. This is not persuasive since what the applicant has claimed is a secondary communication link that bypasses the modem. Applicant has not claimed that the secondary communication link has to bypass a LAN port. The LAN port has multiple communication links such as 6 and 7 that bypass the modem 22 and thus there are at least two links that bypass the modem.

7. Applicant argues that the five scenarios disclosed in cols. 3-4 are 5 separate configurations with 5 separate links and thus does not meet applicant's limitation of an alternate link. This is not persuasive since the links as claimed and explained through the reference in this and prior actions are alternative links since if one connection is broken such as connection 6, an alternative connection may be attempted, such as through 7. Applicant says that Carnahan has "five different configurations for remote demonstration and training". So if one configuration with, as an example, connection 6 may not work, but an alternative configuration may be attempted, such as connection 7.

8. Applicant argues that each configuration in Carnahan is through a single communication link and in effect is arguing that an alternate link is not disclosed in Carnahan. This is not persuasive since if one configuration with, as an example, connection 6 does not work, an alternative configuration with connection 7 may be attempted.

9. *Response to Amendment*

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 8, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Carnahan.
12. As per claim 8, Carnahan teaches a method of testing the operation of a modem in a computer using a ~~portable~~ modem testing device, the method comprising: coupling the modem in the computer (Carnahan fig. 1: 22, 23, 24) to the ~~portable~~ modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4); coupling the computer (Carnahan fig. 1: 24) to the modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4) via an alternate communication link that bypasses the modem (Carnahan fig. 1: connection 7 bypasses modem 22); sending a signal to a computer via the alternate communication link to initialize the modem in the computer (Carnahan fig. 1: 2B sends a signal via 7 and 23 to 24); ~~initiating~~ transmitting of test data from the ~~portable~~ modem testing device (Carnahan fig. 1: 2B sends a signal – during testing, this would be a test signal); receiving the transmission from the ~~portable~~ modem testing device at the modem in the computer (Carnahan fig. 1: 2B sends a signal to modem in the computer 22, 23, 24 via 5 and 8B); and verifying the transmission (inherent to verify transmission when testing a modem); transmitting test data from the modem (Carnahan fig. 1: 22, 23, 24 send signals - during testing, these would be test signals) to the modem testing device (Carnahan fig. 1: 2B); verifying the test data (inherent to verify test data when testing).
13. As per claim 19, Carnahan teaches that the modem testing device comprises a memory with the computer 24 as well as 4, 2A and 2B since computers function by running software programs from memory and storing data in memory and they have microprocessors. It is inherent to store test data in memory, if not permanently, at least for the purpose of determining whether a communication channel exists. When testing, the microprocessor would be involved in determining the validity of the test.

14. *Claim Rejections - 35 USC § 103*

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

16. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1, 3, 4, 5, 11, 12, 13-16, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carnahan in view of Wilska 6427078.

18. As per claim 1, Carnahan teaches a device for testing ~~the operation of a modem in a computer~~, the device comprising: a case (inherent to be within a case to reduce the effect of temperature, humidity, liquid spilling and other environmental effects); a first communication port (Carnahan fig. 1: 23) attached to the case (Carnahan fig. 1: 23 is attached to case 11) and configured to be directly coupled to a modem in a computer (Carnahan fig. 1: 22, 23, 24) thereby forming a primary communication link receive signals from a modem in a computer; a second communication port (Carnahan fig. 1: 5) coupled to a signal reporting circuit (Carnahan fig. 1: 2B) and configured to be coupled with the computer (Carnahan fig. 1: 5 configured to be coupled to computer 24 via other components) and to bypass the modem (Carnahan fig. 1: connection 7 bypasses modem 22) thereby forming a secondary communication link that bypasses the modem (Carnahan fig. 1: connection 7 bypasses modem 22) and wherein the signal reporting circuit is located within the case (Carnahan fig. 1: 2B is located within case 11) and coupled to the first communication port (Carnahan fig. 1: 2B is coupled to 23 via connection 7) and the second communication port (Carnahan fig. 1: 2B is coupled to 5), the signal reporting circuit including a

microprocessor (Carnahan fig. 1: inherent inside 2B) configured to send a signal to the computer via a secondary communication link (Carnahan fig. 1: 2B sends a signal via 7 and 23 to 24) to evaluate test the transmit capability of the modem in the computer over the primary communication link (It is inherent to evaluate the transmit capability based on whether a receiver receives the transmitted signal.)

19. Carnahan does not teach initiating the transmission of test data from the modem in the computer via the primary communication link.

20. It is common knowledge to have a secondary communication link initiate transmission of test data from the primary communication link.

21. It would have been obvious to one skilled in the art at the time of the invention to modify Carnahan to have a secondary communication link to initiate transmission of test data from the primary communication link.

22. One would be motivated to do so since it would be advantages to have backup communication routes if a primary communication route fails or is clogged with traffic.

23. Carnahan does not teach wherein the primary and secondary communication links provide separate paths to the computer. What Wilska teaches is wherein the primary (Wilska: IR link 12) and secondary (Wilska: cellular link 17) communication links provide separate paths to the computer (Wilska: paths from 12 and 17 are separate). It would have been obvious to one skilled in the art at the time of the invention to modify Carnahan with the teachings of Wilska. One would have been motivated to do so to have a multipurpose device as taught in Wilska col. 1.

24. As per claim 3, Carnahan teaches the device of claim 1 wherein the signal reporting circuit comprises a microprocessor and an analog to digital converter coupled to the microprocessor and the first communication port (Carnahan fig. 1: inherent since 2A shows an analog signal and the data has to go to computer, modem, port, etc. which are all digital)

25. As per claim 4, Carnahan teaches the device of claim 1 wherein the signal reporting circuit comprises a microprocessor and a modem coupled to the microprocessor and the first communication port (Carnahan fig. 1: 2B, 5, 22, 23).

26. As per claim 5, Carnahan teaches a method of testing ~~the operation of a modem in a computer~~ using a portable modem testing device, the method comprising: coupling the modem in the computer (Carnahan fig. 1: 22, 23, 24) to the portable (not in Carnahan but would be obvious – see below) modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4) via a first communication link (Carnahan fig. 1: 8B); coupling the computer (Carnahan fig. 1: 24) to the portable modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4) via an alternate communication link and to bypass the modem (Carnahan fig. 1: 24 to 23 to 3A via 6 to 2A to 4 bypasses modems 5, 22); sending a signal from the portable modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4) to the computer (Carnahan fig. 1: 24) via the alternate communication link (Carnahan fig. 1: 24 to 23 to 3A via 6 to 2A to 4 bypasses modems 5, 22) to initiate testing the operation of the modem in the computer; initiating transmission of test data from the modem (not in Carnahan but would be obvious as explained below); receiving the transmission (Carnahan fig. 1: 8A) from the modem

(Carnahan fig. 1: 22) at the portable modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4); and verifying the transmission (inherent to verify transmission when testing a modem).

27. Carnahan teaches a modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4) but does not teach a portable modem testing device.
28. It is common knowledge to make things portable.
29. It would have been obvious to one skilled in the art at the time of the invention to modify make the elements portable.
30. One would be motivated to do so since it has been held that to make something portable requires routine skill in the art.
31. Carnahan does not teach to initiate testing the operation of the modem in the computer and to initiate transmission of test data from the modem. It is common knowledge to send a signal from the portable modem testing device to the computer via the alternate communication link to initiate testing the operation of the modem in the computer and initiate transmission of test data from the modem.
32. It would have been obvious to one skilled in the art at the time of the invention to modify Carnahan to have a secondary communication link to initiate transmission of test data from the primary communication link.
33. One would be motivated to do so since it would be advantages to have backup communication routes if a primary communication route fails or is clogged with traffic.
34. It is also common knowledge to test modems.
35. It would also have been obvious to one skilled in the art at the time of the invention to modify Carnahan to test the modem.

36. One would be motivated to do so in order to know that one has a modem that functions.
37. Carnahan does not teach wherein the primary and secondary communication links provide separate paths to the computer. What Wilska teaches is wherein the primary (Wilska: IR link 12) and secondary (Wilska: cellular link 17) communication links provide separate paths to the computer. It would have been obvious to one skilled in the art at the time of the invention to modify Carnahan with the teachings of Wilska. One would have been motivated to do so to have a multipurpose device as taught in Wilska col. 1.
38. As per claim 11, Carnahan teaches a method of testing the operation of a modem in a computer using a ~~portable~~ modem testing device, the method comprising: coupling the modem in the computer (Carnahan fig. 1: 22, 23, 24) to the ~~portable~~ modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4, 2B); coupling the computer (Carnahan fig. 1: 24) to the modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4, 2B) via an alternate communication link (Carnahan fig. 1: connection 7 is an alternate link); initiating transmission of test data from the modem by sending a signal from the modem testing device over the alternate communication link (not in Carnahan but would be obvious as explained below); receiving the transmission (Carnahan fig. 1: 8A) from the modem (Carnahan fig. 1: 22) at the modem testing device (Carnahan fig. 1: 5, 3B, 2A, 4); verifying the transmission (inherent to verify transmission when testing a modem); initiating transmission of test data from the ~~portable~~ modem testing device (Carnahan fig. 1: 2A, 2B send signals – during testing, these would be a test signals); receiving the transmission from the ~~portable~~ modem testing device at the modem (Carnahan fig. 1: 24 receiving from 2A, 2B); and verifying the transmission (inherent to verify when testing).

39. Carnahan does not teach initiating transmission of test data from the modem by sending a signal from the modem testing device over the alternate communication link. It is common knowledge to send a signal from the modem testing device over the alternate communication link to initiate the transmission of test data from the modem.

40. It would have been obvious to one skilled in the art at the time of the invention to modify Carnahan to have an alternate communication link to initiate transmission of test data.

41. One would be motivated to do so since it would be advantages to have backup communication routes if a primary communication route fails or is clogged with traffic.

42. It is also common knowledge to test modems.

43. It would also have been obvious to one skilled in the art at the time of the invention to modify Carnahan to test the modem.

44. One would be motivated to do so in order to know that one has a modem that functions.

45. As per claim 12, Carnahan does not teach RJ11 jack. It is common knowledge to have a RJ11 jack. It would have been obvious to one skilled in the art at the time of the invention to modify Carnahan to teach a RJ11 jack since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

46. As per claims 13-16, 22 and 23, Carnahan teaches memory, storing test data and software in the memory, microprocessor with the computer 24 as well as 4, 2A and 2B since computers function by running software programs from memory and storing data in memory and they have

microprocessors. It is inherent to store test data in memory, if not permanently, at least for the purpose of determining whether a communication channel exists. When testing, the microprocessor would be involved in determining the validity of the test.

47. *Allowable Subject Matter*

48. Claims 17, 18, 20, 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
49. See prior action for details.
50. Claims 24-27 are allowed based on reasoning supplied in the prior action.

51. *Conclusion*

52. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
53. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

54. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pankaj Kumar whose telephone number is (703) 305-0194. The examiner can normally be reached on Mon, Tues, Wed and Thurs after 8AM to after 6:30PM.

55. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad H. Ghayour can be reached on (703) 306-3034. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

56. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

57.

59. PK

58.

TEMESGHEN GHEBRETSN SAE
PRIMARY EXAMINER